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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,762	01/21/2000	Tetsuo Watanabe	3190-004	4870

7590

12/05/2002

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EXAMINER

MULCAHY, PETER D

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 12/05/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,762

Applicant(s)

WATANABE ET AL.

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobylivker et al., U.S. Patent 6,002,064.

The rejection as set forth under 35 U.S.C. § 102 in Paper No. 9 is deemed proper and is herein repeated.

Applicants extensively argue that the instantly claimed invention is directed to a medical adhesive tape or sheet which is not encompassed by the laminate as shown in the art. This is not persuasive. The Examiner is interpreting the claim to be directed to a sheet material. This sheet material may be a medical sheet but is not seen to be limited to a bandage or medical application device as is being argued by applicants. This is to say that the sheet material as claimed is fully embodied by the sheet material which is shown in Kobylivker. The fact that Kobylivker makes gowns or other surgical wear out of the sheet material does not render the sheet as claimed patentably distinct. Furthermore, the sheet of Kobylivker is taught to have an adhesive applied to its surface. See column 9 lines 35+. This intermediate step of having a sheet material which has an adhesive applied thereon fully embodies applicants' instantly claimed invention. Applicants' invention is directed to the adhesive being either directly or indirectly applied to the substrate material. This is seen to be fully encompassed by a laminate as shown in Kobylivker.

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobylivker taken in view of Joseph et al., U.S. Patent 6,107,219, Hodgson, U.S. Patent 3,645,835 or Potter, U.S. Patent 4,595,001.

Should applicants' claims be interpreted so as to specifically read on an adhesive tape which has an outer layer of pressure sensitive adhesive, then the claims remain unpatentable in view of the art as cited supra.

Specifically, the Kobylivker patent is seen as clearly showing applicants' instantly claimed substrate comprised of the thermoplastic resin and the silicic acid compound. This patent is directed to medical laminates which are formulated into sheets and is not at all limited to the end use of the sheet product disclosed. Specifically this patent at the paragraph bridging columns 9 and 10 identifies the end use of the laminates is varied and readily understood by one of ordinary skill in the art. The secondary references cited herein are directed to bandage applications which incorporate a substrate and an external adhesive layer. These patents further incorporate thermoplastic resin substrates as well as laminates which are useful in the medical tape and bandaging arts. The Examiner maintains that it would be prima facie obvious to utilize the laminate as shown in Kobylivker in a medical tape or bandage application as shown in the secondary references given that one of ordinary skill in the art would readily appreciate its end use potential in such applications. There is nothing in Kobylivker that would exclude such bandaging and/or medical tape

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applications and to the contrary it is seen that this laminate would be suitable in these medical adhesive applications.

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants' claim recitation "directly or indirectly laminated thereon," is indefinite. It is unclear as to exactly how this further limits the claim. It is unclear as to whether or not the adhesive is applied so as to form a layer which is either directly attached to the substrate layer or to an intermediate layer between the substrate layer and the adhesive layer or is this language intended to limit the method of application of adhesive? As can be seen by the Kobylivker patent at column 9 lines 35+, there are many methods for forming laminates and applying an adhesive layer to the sheet material and as such it is unclear as to exactly what or how an indirect versus direct method of application is to limit the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 305-3599.


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Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
December 2, 2002


PETER D. MULCAHY
PRIMARY EXAMINER